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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT PAPER NUMBER

1772

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/715,562

Applicant(s)

O'CONNOR, LAWRENCE J.

Examiner

Patricia L. Nordmeyer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Withdrawn Rejections***

Any rejections and or objections, made in the previous Office Action, and not repeated below, are hereby withdrawn.

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 – 43 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 78 and 80 – 82 of copending Application No. 10/821,202. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed towards coverings for use on an exterior surface made with fibrous layers, moldable layers and release sheets covering the back surface of the moldable layer.

Application 10/821,202 a covering for use on an exterior surface comprising a fibrous

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layer having a back surface, a moldable layer applied at a volume of least about 185 grams per square meter to the entire back surface of the fibrous layer, a release sheet releasably secured to the bottom surface of the moldable layer (Claim 1) and the covering is a composite strip that is elongated with a predetermined length and has a predetermined width, the predetermined width being less than the length (Claim 6), wherein the predetermined length is at least 25 feet (Claim 8). The moldable layer being formed of a hot melt adhesive (Claim 9), and the fibrous layer is a mat formed by needle punching (Claim 10). The release sheet is formed of a silicon-coated material (Claim 15) having a separate central release strip (Claim 16).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1 – 43 are directed to an invention not patentably distinct from claims 1 – 78 and 80 – 82 of commonly assigned Application 10/821,202. Specifically, both articles contain coverings for use on an exterior surface are made with fibrous layers, moldable layers and release sheets covering the back surface of the moldable layer.

3. Claims 1 – 43 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 21 of copending Application No. 11/023,412. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed towards coverings for use on an

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exterior surface that are made with fibrous layers, moldable layers and release sheets covering the back surface of the moldable layer.

Application 11/023,412 a covering for use on an exterior surface comprising a fibrous layer having a back surface (Claim 1), a moldable layer, adhesive layer, applied at a volume of least about 185 grams per square meter to the entire back surface of the fibrous layer (Claim 4), a release sheet releasably secured to the bottom surface of the moldable layer (Claim 1).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1 – 43 are directed to an invention not patentably distinct from claims 1 – 21 of commonly assigned Application 11/023,412. Specifically, both articles contain coverings for use on an exterior surface are made with fibrous layers, moldable layers and release sheets covering the back surface of the moldable layer.

4. Claims 1 – 43 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 19 of copending Application No. 11/023,413. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed towards coverings for use on an exterior surface that are made with fibrous layers, adhesive layers and release sheets covering the back surface of the moldable layer.

Application 11/023,413 a covering for use on an exterior surface comprising a fibrous layer having a back surface (Claim 1), a moldable layer, adhesive layer, applied at a volume of least about 185 grams per square meter to the entire back surface of the fibrous layer (Claim 14), a release sheet releasably secured to the bottom surface of the moldable layer (Claim 1).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1 – 43 are directed to an invention not patentably distinct from claims 1 – 19 of commonly assigned Application 11/023,413. Specifically, both articles contain coverings for use on an exterior surface are made with fibrous layers, adhesive layers and release sheets covering the back surface of the moldable layer.

5. Claims 1 – 43 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 20 of copending Application No. 11/034,255. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed towards coverings for use on an exterior surface that are made with fibrous layers, adhesive layers and release sheets covering the back surface of the moldable layer.

Application 11/034,255 a covering for use on an exterior surface comprising a fibrous

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layer having a back surface (Claim 1), a moldable layer, adhesive layer, applied at a volume of least about 185 grams per square meter to the entire back surface of the fibrous layer (Claim 6), a release sheet releasably secured to the bottom surface of the moldable layer (Claim 1).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1 – 43 are directed to an invention not patentably distinct from claims 1 – 20 of commonly assigned Application 11/034,255. Specifically, both articles contain coverings for use on an exterior surface are made with fibrous layers, adhesive layers and release sheets covering the back surface of the moldable layer.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 30 – 32, 36 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Friedlander et al. (USPN 4,695,493).

Friedlander et al. disclose a elongate composite strip in the form of a supply roll (Column 6, lines 64 – 68) comprising a layer of fibrous floor covering material having a fibrous front and back surface (Figure 1, #4, 6 and 8; Column 4, lines 6 – 7), a mold layer formed of hot melt adhesive (Column 3, lines 1 – 5) covering the entire back surface of the strip having a bottom surface with an adhesive property for attaching the fibrous floor covering material (Figure 1, Adhesive layer) with a thickness of 1 to 20 mil (Column 3, lines 29 – 31) and a release sheet on the attachment layer which is arranged to be removed for the attachment of the attachment layer to the surface (Figure 1, #20; Column 2, lines 55 – 57), wherein the composite has a predetermined length and width, the width being less than the length (Column 6, lines 65 – 68). The elongated strip is capable of being rolled longitudinally while remaining resilient and possesses elasticity during the application (Figure 3). The composite strip is arranged to provide no resistance to bending of the fibrous layer and the attachment layer from a rolled condition to a flat condition for attachment to a generally flat surface and to by follow gravity generally any undulations in the flat surface (Column 4, lines 24 – 31). The moldable layer is formed of hot melt adhesive (Column 3, lines 1 – 3) having a thickness of 1 to 20 mil (Column 3, lines 28 – 30), while the fibrous layer is mat formed by needle punching, tufted, woven or carpet (Column 4, lines 62 – 68) and the release sheet is a silicon-coated material (Column 5, lines 1 – 6) as in claims 20, 21, 31 and 36.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:



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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1 – 6, 13 – 23, 30 – 37 and 41 – 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haas et al. (USPN 4,554,194) in view of Friedlander et al. (USPN 4,695,493).

Haas et al. disclose a elongate composite strip, band, (Column 2, lines 53 – 54) in the form of a supply roll (Column 4, lines 36 – 38) comprising a layer of fibrous floor covering material having a fibrous front and back surface (Figure 1, #4; Column 5, lines 28 – 30), a mold layer formed of hot melt adhesive forming a solid bottom surface with an adhesive quality (Figure 1, #2 and 3, wherein both layers are directed towards bonding the composite to a surface; Column 12, lines 60 – 62) having a coating weight per unit area of between about 35 and 60 grams per square meter (Column 11, lines 49 – 51; Column lines 42 – 43), the strip having a bottom surface with an adhesive property for attaching the fibrous floor covering material (Figure 1, #2; Column 5, lines 46 – 60) and a release sheet, a synthetic resin (Column 4, lines 5 – 12) on the attachment layer which is arranged to be removed for the attachment of the attachment layer to the surface (Figure 4, #12; Column 7, lines 10 – 23), wherein the composite has a predetermined length and width, the width being less than the length (Column 2, lines 53 – 54). With regard to the back surface of the covering, the back surface is rough and the moldable layer conforms to the back surface (Figure 1; Column 5, lines 53 – 60). The composite strip is arranged to provide no resistance to bending of the fibrous layer and the attachment layer from a rolled condition to a flat condition for attachment to a generally flat surface and to by follow gravity generally any undulations in the flat surface (Column 9, lines 64 – 68). The moldable

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layer is formed many types of adhesive including hot melt adhesive (Figure 1, #2; Column 12, lines 60 – 62), while the fibrous layer is mat is a non-woven carpet (Column 5, lines 35 – 37). However, Haas et al. fail to disclose the moldable layer covering the entire back surface at a volume of at least 185 grams per square meter, the moldable layer being applied at a coating weight of between about 185 and 465 grams per square meter, the moldable layer being between about 5 mils and 17 mils thick, 13 mils and 17 mils thick, on the average of about 13 mils thick, the release sheet being formed of a silicon coated material and the fibrous layer being a mat formed by needle punching.

Friedlander et al. teach the moldable layer being formed of pressure sensitive adhesive (Column 3, lines 1 – 3) having a thickness of 1 to 20 mil (Column 3, lines 28 – 30), while the fibrous layer is mat formed by needle punching, tufted, woven or carpet (Column 4, lines 62 – 68) and the release sheet is a silicon-coated material (Column 5, lines 1 – 6) for the purpose of forming a carpet that may be formed or reformed by hand into a stable shape and remains unchanged during the life of the article (Column 2, lines 34 – 44).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the thickness of the moldable layer along with the release sheet in Haas et al. in order to form a carpet that may be formed or reformed by hand into a stable shape and remains unchanged during the life of the article as taught by Friedlander et al.

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With regard to the moldable layer being applied at a coating weight of between about 185 and 600 grams per square meter, the attachment layer having a coating weight per unit area of greater than 185 grams/sq meter or 300 grams/sq meter and the total material applied in the attachment layer and in between the barrier layer and the layer of fibrous floor covering material having a weight per unit area of greater than 300 grams/ sq meter, 400 grams/ sq meter or 600 grams/ sq meter, it would have been obvious to one having ordinary skill in the art at the time the invention was made to change the coating weight of the moldable and attachment layers and the total material weight applied, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. MPEP2144.05.

10. Claims 7, 8, 12, 24, 25, 29 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haas et al. (USPN 4,554,194) in view of Friedlander et al. (USPN 4,695,493) as applied to claims 1 – 6, 13 – 23, 30 – 37 and 41 – 43 above, and further in view of Kalwara et al. (USPN 6,426,129).

Haas et al., as modified with Friedlander et al., discloses a covering for an external surface as shown above but fails to disclose the barrier layer having a first width and the fibrous layer having a second width, wherein the second width is greater than the first width, the predetermined width being less than 12 inches, the predetermined length being at least 25 feet, and the release sheet having free edges that extend beyond the fibrous layer and moldable layer to provide a grasping surface at the edges of the composite covering strip.

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Kalwara et al. teach a covering for an external surface wherein the barrier layer having a first width and the fibrous layer having a second width, wherein the second width is greater than the first width (Figure 2, #12 and 14), the composite strip being elongated with a predetermined length and having a predetermined width, the predetermined width being less than the predetermined length (Column 5, lines 7 – 10), the predetermined width being less than 12 inches (Column 5, lines 9), the predetermined length being at least 25 feet (Column 5, line 8), and the release sheet having free edges that extend beyond the fibrous layer and moldable layer to provide a grasping surface at the edges of the composite covering strip (Figure 2, #20) for the purpose of having a release liner that is easily to disengage from the tacky surface of the adhesive layer (Column 5, lines 39 – 46).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the desired lengths and widths of materials in the composite to cover an exterior surface in the modified Haas et al. in order to have a release liner that is easily to disengage from the tacky surface of the adhesive layer as taught by Kalwara et al.

11. Claims 9 – 11, 26, 27, 28 and 37 – 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haas et al. (USPN 4,554,194) in view of Friedlander et al. (USPN 4,695,493) as applied to claims 1 – 6, 13 – 23, 30 – 37 and 41 – 43 above, and further in view of Tajima et al. (USPN 3,937,640) and Cain (USPN 5,149,570).

Haas et al., as modified with Friedlander et al., discloses a covering for an external surface where the release coating is made of separably strips (Figure 6a) as shown above but fails to disclose the release sheet has a separate central release sheet, the release sheet is formed with a plurality of strips or three separably removable strips with one on each edge and one in the center, the middle strip overlapping the edge strips, the width of one strip being less than at least one of the strips.

Tajima et al. teach a covering for an external surface wherein the release sheet has a separate central release sheet, the release sheet is formed with a plurality of strips or three separably removable strips with one on each edge and one in the center, the middle strip overlapping the edge strips, the width of one strip being less than at least one of the strips (Figure 3A and 3B, #14; Column 7, lines 49 – 58) for the purpose of rendering the application of the covering for an external surface easier (Column 7, lines 57 – 58).

Cain teaches a release liner having overlapping edges (Figure 3, #30) for the purpose of forming a pull tap to facilitate removal of the release sheet (Column 3, lines 27 – 28).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the various methods of applying a release sheet to the back surface of an external covering in the modified Haas et al. in order to render the application of the covering for an external surface easier as taught by Tajima et al. and to facilitate removal of the release sheet as taught by Cain.

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12. Claims 30 – 32, 36 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haas et al. (USPN 4,554,194) in view of Friedlander et al. (USPN 4,695,493) as applied to claims 1 – 6, 13 – 23, 30 – 37 and 41 – 43 above, and further in view of O'Connor (USPN 5,475,952).

Haas et al., as modified with Friedlander et al., discloses a covering for an external surface where the release coating is made of separably strips (Figure 6a) as shown above but fails to disclose a treated lumber covering, the composite strip being applied to a surface of the board and forms an impermeable bond with a surface of the board of treated lumber.

O'Connor teaches a treated lumber covering (Column 1, lines 3 – 6), the composite strip being applied to a surface of the board and forms an impermeable bond with a surface of the board of treated lumber (Column 3, lines 1 – 7) made with a layer of fibrous material (Column 4, lines 4 – 21) for the purpose of having a covering on a treated lumber surface that protects the users from the possibility of splinters (Column 1, lines 16 – 20),

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the treated lumber covering made with a fibrous material using the material in the modified Haas et al. in order to have a covering on a treated lumber surface that protects the users from the possibility of splinters as taught by O'Connor.

***Response to Arguments***

13. Applicant's arguments with respect to claims 1 – 43 have been considered but are moot in view of the new ground(s) of rejection. However, since some of the prior art is being applied in the new rejections above, the arguments will be responded to below.

In response to Applicant's argument that the double patenting fails to show a prima facie case of obviousness, please see the newly presented rejections above.

In response to applicant's argument that Tajima and Kalwara are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Tajima and Kalwara et al. are in the field of the applicant's endeavor, i.e. a covering for exterior use. Tajima teaches the release sheet is formed with a plurality of strips or three separably removable strips with one on each edge and one in the center, the middle strip overlapping the edge strips, the width of one strip being less than at least one of the strips (Figure 3A and 3B, #14; Column 7, lines (Column 7, lines 49 – 58) as part of a roofing laminate, which is a covering for exterior use. Kalwara et al. teaches a covering for an external surface wherein the barrier layer having a first width and the fibrous layer having a second width, wherein the second width is greater than the first width (Figure 2, #12 and 14), the composite strip being elongated with a predetermined length and having a predetermined width, the predetermined width being less than the predetermined length

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(Column 5, lines 7 – 10), the predetermined width being less than 12 inches (Column 5, lines 9), the predetermined length being at least 25 feet (Column 5, line 8), and the release sheet having free edges that extend beyond the fibrous layer and moldable layer to provide a grasping surface at the edges of the composite covering strip (Figure 2, #20).

In response to Applicant's argument that Haas fails to disclose a coating weight between 185 and 600 gsm, please see the newly presented rejections above.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patricia L. Nordmeyer

Examiner

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pln